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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,141	03/15/2001	Daniel Lieberman	7544-PA02	5355

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EXAMINER

CULBERT, ROBERTS P

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 12/18/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/809,141

Applicant(s) <sup>XB</sup>

LIEBERMAN, DANIEL

Examiner

Roberts Culbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

The phrases, “for adjusting location of said demetalization roll” and “to move said demetallization roll” are not clear and precise because the specification indicates that the speed and not the position of the roll is adjusted by the indexing means. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

While the roller and film are in contact, they move together at the same speed, and the position of the roller surface relative to the web surface remains the same. According to the specification, the registration marks are used to adjust the speed of the roller and film. It is not clear how the changing speed of the roller and film causes the demetalization to occur in register

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with a pattern since the pattern is determined by the pattern on the etchant print-roller and not the roller speed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,959,120 to Wilson in view of U.S. Patent 5,128,779 to Mallik and in view of U.S. Patent 4,745,288 to Hurley et al.

Wilson teaches a method for the selective demetallization of a web coated with a metal film. Referring to figure 7, Wilson shows conveying the web material through a demetallization station whereby predetermined portions of the metal film are removed or thinned to create or reveal visual elements of the web material.

Wilson does not show the use of a web having a preprinted image. Wilson only suggests that the process is useful for making security documents such as a credit card (Col. 7, Line 29-32). Mallik shows a web coated with a metallic foil for producing the same type of authenticating documents (Col 1, Lines 15-20). The web has printed information on the surface. See figure 1. It would have been obvious to one of ordinary skill in the art at the time of invention to use a preprinted web as shown by Mallik in the method of Wilson in order to produce a security document that contains suitable information, such as personal identification.

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Motivation to use the material of Maillik with the demetalization process of Wilson is likewise given in Mallik (Col. 6, Lines 21-32 and 54-59).

Wilson also does not show demetallizing the web in registration with a preprinted image. Mallik, however, does show the demetalization in registration with the preprinted image. See figure 2. It would have been obvious to one of ordinary skill in the art at the time invention to demetallize the web in registration with a preprinted image in order to create a feature that cannot be easily altered or duplicated. The visual information behind the hologram on a surface to which it is attached can then be viewed through the non-reflective areas of the hologram (Col. 2, Lines 44-46).

Wilson in view of Mallik does not show an automated means for demetallizing the web in registration with a preprinted image. It may be assumed that the film is manually aligned with the printing roll since no other method is given. Hurley teaches the use of a controller to sense the presence and location of registration marks on a web as the web passes a scanner. Then the controller sends a signal to modify downstream operations such as printing. See abstract. It would have been obvious to one of ordinary skill in the art at the time invention to use the controller of Hurley in the printing method of Wilson in view of Mallik in order to automate a manual activity. See *In re Venner* 120 USPQ 193, 194 (CCPA) 1958.

Regarding claims 2-6 and 11-12, the office takes notice that the several listed methods of image formation and web materials used are old and well known in the art of secure document production and that one of ordinary skill would be expected to know them.

Regarding claim 7, Mallik teaches the attachment of the demetalized web to another web having images thereon, using an adhesive between materials, and thereafter adhesively

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transferring, in registration, areas of images from the second web to the demetallized web by a cold foil stamping process (Col. 4, Line 63- Col. 5, Line 5). Note that both hot and cold stamping processes are old and well-known methods in the art of producing secure documents.

Regarding claims 8 and 10, Mallik shows demetalization revealing designs or patterns hidden in the original images on the web. Mallik also shows removal of metal from an area adjacent to but not covering originally placed images. See figures 2, 9 and 10. It would have been obvious to one of ordinary skill in the art at the time of invention to selectively remove the metal over and around the pre-placed images on the web in order to increase the difficulty of counterfeiting the structure.

Regarding claim 9, the use of moiré patterns in security documents such as currency is old and well known in the art as admitted by applicant in paragraph 35. It would have been obvious to one of ordinary skill in the art at the time invention to use a moiré pattern in order to produce a document that is extremely difficult to duplicate.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Walters shows a similar pattern demetalization for security documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (703) 305-7965. The examiner can normally be reached on Monday-Friday (7:30-4:00).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (703) 308-1633. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

December 16, 2002

  
GREGORY MILLS  
SUPERVISOR, PATENT EXAMINER  
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